

REMARKS

In the Office Action mailed on April 18, 2006, the Examiner rejected claims 1, 2, 4-7, 120, 121, 124, 126, 127, 129, 131-135, 137, 138, 140, 142, 144-152, 154-157, and 164-171 under 35 U.S.C. § 102(b) as allegedly being anticipated by Porter (U.S. Patent No. 5,676,676); and rejected claims 130, 143, and 153 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Porter in view of Yoon (U.S. Patent No. 5,695,505).

The Examiner made the rejections final.

By this Amendment, Applicants propose to amend claims 1, 120, 135, and 148, and cancel claims 168-171 without prejudice or disclaimer. Claims 1, 120, 135, and 148 have been amended to substantially include, among other things, the subject matter of claims 168-171, respectively. Accordingly, claims 1, 2, 4-7, 120-121, 124, 126, 127, 129-135, 137-138, 140, 142-157, and 164-167 are currently pending. Of these claims, claims 1, 120, 135, and 148 are independent.

Applicants respectfully traverse the Examiner's rejection of claims 1, 2, 4-7, 120, 121, 124, 126, 127, 129, 131-135, 137, 138, 140, 142, 144-152, 154-157, and 164-171 under 35 U.S.C. § 102(b). Each of independent claims 1, 120, 135, and 148 requires, among other things, a device (e.g., a clip) that comprises first and second arms connected to each other at a first end (e.g., the proximal end) so as to define an opening (or gap) that allows tissue to extend from the connection beyond a second end (e.g., the distal end) of each of the first and second arms when the tissue is secured between the arms. In addition, claims 1, 120, 135, and 148 require that the second end of the first arm maintain a non-contacting relationship with the second end of the second arm when the device is in a final tissue-fold-secur ing position. Furthermore, claims 1,

120, 135, and 148 recite that the second end of each of the first and second arms includes a distalmost surface of the respective arm that is furthest from the first end of the respective arm.

Porter discloses a ligating clip 10 including first and second legs 12 having proximal ends 14 and distal ends 16. The proximal ends 14 of each leg 12 are joined together by a hinge 22. The legs 12 are movable about hinge 22 between an open position for receiving a vessel 50, and a closed position for securing the vessel 50. See, e.g., Porter, col. 2, lines 36-37; col. 3, line 56 - col. 4, line 12; and Figs. 5-7. In the closed position, the distal ends 16 of the legs 12 are secured together by lock tab 26 and lock slot 28. See, e.g., Fig. 7.

Porter, however, fails to disclose that the second end of the first arm is configured to maintain a non-contacting relationship with the second end of the second arm when the device is in the final tissue-fold-securing position, wherein the second end of each of the first and second arms includes a distalmost surface of the respective arm that is furthest from the first end of the respective arm, as required by independent claims 1, 120, 135, and 148.

Insofar as the rejection of claims 168-171 is relevant to amended claims 1, 120, 135, and 148, Applicants respectfully disagree with the assertions in that rejection. In rejecting claims 168-171, the Examiner refers to Fig. 2 of Porter and contends that "Porter teaches the distal ends of the arms to be configured to maintain a non-contacting relationship with each other []. For claims 168-171, ears 34 are not considered to be part of the arms. They merely extend from the distal end of the arms (col. 2, lines 64-65)." See April 18, 2006, Office Action at page 4 (emphasis in original).

In addition, the Examiner reproduced Fig. 2 of Porter and annotated it to indicate that the “arm[s]” of Porter only extend to shoulders 36 of ears 34. *Id.* Applicants respectfully disagree with this interpretation of the Porter reference.

The cited portions of Porter, or any other portion of Porter, do not support the asserted position. Column 2, lines 64-65, of Porter states that “[a]n ear 34 extends outward at *the distal end 16 of each leg 12* of the ligating clip 10.” (Emphasis added.) As shown in Figs. 2, 5, 6, and 7, reference numeral “16” corresponds to the terminal ends of legs 12. Accordingly, the teachings of Porter clearly identify that the distal ends of legs 12 include the distalmost surfaces identified at reference numeral “16.” Therefore, rather than extending only to shoulders 36, as alleged by the Examiner, legs 12, as explicitly taught by Porter, extend past shoulder 36 to the distalmost ends 16. See, e.g., Figs. 1, 2, 5, 6, and 7. Furthermore, as shown in Fig. 7, distal ends 16 of each leg 12 are configured to be in contact with each other when clip 10 is in a final tissue-securing position.

Even assuming that Porter can be interpreted to suggest that legs 12 only extend to the shoulders 36, and that the distal ends of such legs are in a non-contacting relationship, which Applicants do not concede (especially since such an interpretation is contrary to the explicit teachings of Porter), Porter still fails to anticipate at least claims 1, 120, 135, and 148 because these claims also require the second end of each of the first and second arms to include a distalmost surface of the respective arm that is furthest from the first end of the respective arm. If, as alleged by the Examiner, legs 12 arbitrarily only extended to shoulders 36, legs 12 would not include a distalmost surface

that is furthest from the first end of the leg, as required by independent claims 1, 120, 135, and 148.

Accordingly, Porter fails to teach each and every element of independent claims 1, 120, 135, and 148, and Applicants respectfully request that the rejection be reconsidered and withdrawn.

Applicants respectfully traverse the rejections of claims 130, 143, and 153 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Porter in view of Yoon. Even if Yoon teaches what the Examiner alleges (and Applicants do not necessarily agree that it does), this reference fails to overcome the shortcomings of Porter discussed above. Accordingly, claims 130, 143, and 153 are allowable at least for the reasons discussed above with respect to Porter.

Each of claims 2, 4-7, 121, 124, 126-127, 129-134, 137-138, 140, 142-147, 149-157, and 164-167 depend from one of claims 1, 120, 135, and 148, and are patentable for at least all of the reasons for which these base claims are patentable.

The outstanding Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

In discussing the specification and claims in this Amendment, it is to be understood that Applicants are in no way intending to limit the scope of the claims to an exemplary embodiment described in the specification or abstract and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1, 2, 4-7, 120-121, 124, 126, 127, 129-135, 137-138, 140, 142-157, and 164-167 in condition for allowance. Applicants submit that the proposed amendments of claims 1, 120, 135, and 148 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of this Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of this Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims. If the Examiner would like to discuss this case, he is encouraged to contact the undersigned at (202) 408-4140.

Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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By:


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